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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/623,119

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Carl-Magnus A. Andersson

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EXAMINER

CHANG, CELIA C

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 06/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/623,119	Applicant(s) ANDERSSON ET AL.	
	Examiner Celia Chang	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-8, 17-20, 22-25 and 34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1, 2, 5-8, 18 and 22-24 is/are rejected.
- 7) ☐ Claim(s) 3, 17, 19, 20, 25 and 34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Applicant's election without traverse of group I with species of compound 93 in the reply filed on Mar. 31, 2006 is acknowledged.

Applicants have amended the claims limited to Z1-4 are CR4, W1 is O, S or NR5, W2 is N or CR6, W3 is CG; W1 is NG, W2 is CR5 or N, W3 is CR6 or N, with the election of species of example 93.

Based on the species election, the prosecution is limited to W1 is S, W2 is N or CR6, W3 is CG compounds are examined. This is based on the following reason:

A) An attempt to search the currently amended broad scope rendered the search impossible (see Exhibit A cited on PTO-892, i.e. incomplete results).

B) In the parent application, the same restriction was made. It was of record in the parent application that when the core is indolyl, such compounds have antihypertensive activity (see CA 64:67726); when the core is benzoxazolyl, such compounds have antipsychotic activity (see US 4,458,075, cited on 1449); when the core is benzofuranyl, such compounds have GABA uptake inhibiting activity; when the core is benzothienyl, such compounds have dopamine transporter binding activity (see CA 126:69745). Therefore, not only compounds having separate core structure need to be searched and examined separately, it is also evidenced that such compounds having independent and separate core structure each supports separate patent.

C) In the parent case, based on the species election of example 19, the subject matter of claims 9-12 being drawn to indazolyl compounds are examined. Since claims 4, 13, 21, 30, 69, 70, 72-76 have been canceled, claims 1-3, 5-12, 14-20, 22-68 and 71 reading on the indazolyl (W1 is N, W2 is N, W3 is C) compounds are examined for treating glaucoma. There is no good reason, why the same subject matter needs to be examined again. Especially, in the prosecution history, an enormous number of prior art on the indazolyl compounds were found and excluded from the issued claims in the parent case.

Claims 4, 9-16, 21, 26-33, 35-76 have been canceled. Claims 1-3, 5-8, 17-20, 22-25, 34 reading on the elected benzthienyl/benzthiazolyl core are prosecuted.

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2. Claims 1-2 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terms “heteroalkyl” and “forms cyclic structure” are indefinite. Please note, a heteroatom at the backbone of the alkylene chain or as a substituent are structurally different. The term “forms cyclic structure” without limitation on what the structure is can not be ascertained because different cyclic structure requires different starting material. Absent of description, the scope of such structure can not be ascertained.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5-7, 18, 22-24 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Campaigne et al. US 3,417,087; Robba et al. US 4,186,136; Vitali et al. CA 70:37702; Moltzen et al. CA 119:117118; Nakazato et al. CA 126:8111.

See US 3,417,087, col. 2 , lines12-13;

US 4,186,136 col. 5-6, compounds 13-16;

CA70, RN 19767-24-9, 21309-88-6;

CA119, RN 147372-78-9;

CA126, RN183949-54-4, 183949-55-5.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 5-7, 18, 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campaigne et al. US 3,417,087; Robba et al. US 4,186,136; Vitali et al. CA 70:37702; Moltzen et al. CA 119:117118; Nakazato et al. CA 126:8111 in view of Nakazato et al. 126:8111.

Determination of the scope and content of the prior art (MPEP §2141.01)

Campaigne et al. US 3,417,087; Robba et al. US 4,186,136; Vitali et al. CA 70:37702; Moltzen et al. CA 119:117118; Nakazato et al. CA 126:8111 disclosed anticipatory compounds as delineated supra.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the broad scope from the general teaching of the prior art is that instead of R1-R4 and R10, R10' are hydrogens, the broad scope of the claims encompassed R1-R4 or R10, R10' be alkyl, halo etc.

Finding of prima facie obviousness—rational and motivation (MPEP §2142-2143)

One having ordinary skill in the art in possession of the above reference would be in possession of the substituted compounds encompassed by the broad scope because the species and the general teaching of prior art as a whole rendered the instant broad scope obvious because prior art delineated and enabled such variation, such as compare RN 183949-54-4 and RN 183949-55-5 with the generic teaching of the reference.

5. Claims 3, 17, 19-20, 25, 34 *being drawn to the elected invention* (W1 is S, W2 is N or CR6, W3 is CG) are objected to as being dependent upon a rejected base claim, but would be

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allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The specific R10 being the limitation of claim 2 are neither anticipated nor rendered obvious by the art of record.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie, Ph. D., can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang
Jun 1, 2006


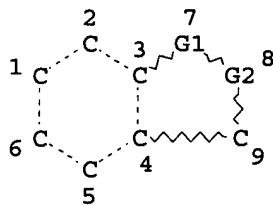

Celia Chang
Primary Examiner
Art Unit 1625

Exhibit A



Ak~N
10 11

VAR G1=O/S/N
VAR G2=N/C
ENTER (DIS), GRA, NOD, BON OR ?:end
L1 STRUCTURE CREATED

=> s l1
SAMPLE SEARCH INITIATED 14:07:56 FILE 'REGISTRY'
SAMPLE SCREEN SEARCH COMPLETED - 177805 TO ITERATE

1.1% PROCESSED 2000 ITERATIONS
INCOMPLETE SEARCH (SYSTEM LIMIT EXCEEDED)
SEARCH TIME: 00.00.01

50 ANSWERS

FULL FILE PROJECTIONS: ONLINE **INCOMPLETE**
BATCH **INCOMPLETE**
PROJECTED ITERATIONS: 3531327 TO 3580873
PROJECTED ANSWERS: 389836 TO 406730

L2 50 SEA SSS SAM L1